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PRE-APPEAL BRIEF REQUEST FOR REVIEW

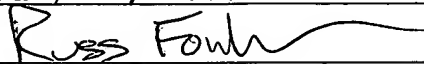
Docket Number (Optional)

1920-0003

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on February 21, 2006

Signature

Typed or printed name Russell E. Fowler II

Application Number

10/071,726

Filed

02/08/2002

First Named Inventor

Jeffrey R. Moritz

Art Unit

1743

Examiner

Brian R. Gordon

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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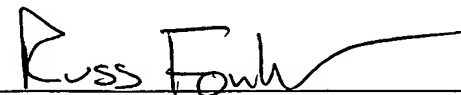
applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 43,615

Signature

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Typed or printed name

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Telephone number

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

February 21, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/071,726
Applicant : Moritz et al.
Filed : February 8, 2002
TC/A.U. : 1743
Examiner : Brian R. Gordon

Confirmation No. 3222

Docket No. : 1920-0003

For: CONDUCTIVE PLASTIC RACK FOR PIPETTE TIPS

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Russ Fowler

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ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant hereby requests review of the final rejection in the above-identified
application for the reasons set forth below.

I. The Examiner Has Not Made a Prima Facie Case of Obviousness for the 35 U.S.C. § 103 Rejection of Claims 21 and 32

In the October 27, 2005 Office action, the Examiner finally rejected claims 21 and 32 under 35 U.S.C. § 103(a) as being obvious and unpatentable over either (i) U.S. Patent No. 4,588,095 to Mehra (hereinafter “Mehra”) or (ii) U.S. Patent No. 4,060,457 to Iizuka (hereinafter “Iizuka”) in view of Mehra. Applicant respectfully submits that the Examiner’s rejection of claims 21 and 32 under 35 U.S.C. § 103(a) is improper, as the Examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142 - 2143.

A. Not All Claim Limitations are Taught or Suggested by the Cited Art

In order to make a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. In this case, Applicant submits that at least one limitation from each of claims 21 and 32 is not suggested or taught by the prior art. In particular, with respect to claims 21 and 32 Applicant submits that at least the limitation that the tip rack comprises “an electrically conductive plastic material operable to discharge static electricity ...” is not disclosed in Mehra or Iizuka.

1. Iizuka

In the October 27, 2005 Office Action, the Examiner admitted that Iizuka does not describe the holder as being comprised of an electrically conductive plastic material (see p. 8, of the October 27, 2005 Office Action).

2. Mehra

In the July 19, 2005 Office action, the Examiner noted that the device disclosed in

Mehra may be made from various injection molding materials, such as polypropylene. The Examiner also noted that Mehra states that the injection molded material may also contain fillers including glass fibers, carbon black, carbon fibers and the like. The Examiner then concluded that “the carbon filled polypropylene is the same material as disclosed by Applicant as such the material inherently has the same properties and is considered to be an electrically conductive plastic material” (emphasis added) (*see* p. 6 of the July 12, 2005 Office Action). This Examiner reached this same conclusion in the Examiner’s October 27, 2005 Office Action finally rejecting claims 21 and 32 (*see* p. 9 of the Examiner’s October 27, 2005 Office Action).

Applicant respectfully submits that the Examiner’s conclusion that the carbon filled polypropylene material in Mehra is the same material as disclosed in the present invention and is therefore an “electrically conductive plastic material” is improper. Although Mehra does disclose an injection molded rack made of polypropylene with carbon fillers, Mehra does not disclose the material as “electrically conductive.” Carbon fillers may be added to plastic material for various reasons and in various associated concentrations. Many plastics include carbons, but not all concentrations of carbon result in an “electrically conductive plastic operable to discharge static electricity” as claimed in claims 21 and 32.

In view of the foregoing, Applicant respectfully submits that the mere disclosure in Mehra of polypropylene with carbon fillers is not a disclosure of an “electrically conductive plastic material operable to discharge static electricity” as claimed in claims 21 and 32. Thus, Mehra does not disclose all the limitations of claims 21 and 32.

B. There is No Suggestion or Motivation in Mehra for the Missing Limitation

In addition to the foregoing, there is no suggestion or motivation in Mehra for using an electrically conductive plastic material. “Obviousness cannot be established ... absent some teaching, suggestion or incentive supporting the combination.” *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). In addition, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, the mere fact that a combination of polypropylene and carbon *could* rise to the level of an electrically conductive plastic material is not a disclosure of such an electrically conductive plastic material, and does not render an electrically conductive plastic material obvious, as there is no suggestion in Mehra of the desirability of such material. To the contrary, Mehra only seems to suggest the desirability of fillers for structural support (i.e., non-conductive glass fibers are the preferred filling material)(see col. 10, lines 26-34 of Mehra). Therefore, there is no suggestion or motivation in the art cited by the Examiner for one of ordinary skill in the art to conclude that the injection molded rack of Mehra should be comprised of electrically conductive plastic material.

For at least the reasons discussed above, the Examiner has failed to make a *prima facie* case that claims 21 and 32 are unpatentable over either Mehra or Iizuka in view of Mehra. Accordingly, it is respectfully submitted that claims 21 and 32 are allowable and the Examiner’s rejection of claims 21 and 32 as obvious over either (i) Mehra, or (ii) Iizuka in view of Mehra, under 35 U.S.C. § 103(a) should be withdrawn.

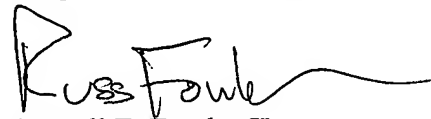
II. The Examiner's October 27, 2005 Office Action Improperly States Applicant's Argument

Applicant notes that on page 2 of the Examiner's October 27, 2005 Office Action, the Examiner states, "As acknowledged by applicant ... the device of Mehra is constructed of the same material of the device as claimed by applicant" (emphasis added). The Examiner cites page 10 of Applicant's October 7, 2005, Response to Office Action as making this admission. It is respectfully submitted that no such admission was ever made by Applicant. To the contrary, Applicant's October 7, 2005, Response to Office Action merely makes the argument that the mere existence of a carbon filler in a polypropylene material does not disclose "an electrically conductive plastic material," as claimed in claims 21 and 32.

III. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the Examiner has not made a *prima facie* case of obviousness, and the Applicant has made a patentable contribution to the art. Favorable reconsideration of pending claims 21-32 is therefore respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Russ Fowler", with a long horizontal flourish extending to the right.

Russell E. Fowler II
Attorney Registration No. 43,615